

Application No. 09/899,789  
Amdt. Dated February 5, 2004  
Reply to Office Action of September 5, 2003

## **REMARKS/ARGUMENTS**

### **1. Response to the Restriction Requirement**

The Examiner has required in the Office Action dated September 5, 2003, that pursuant to 35 U.S.C. §121 and 37 C.F.R. §1.142, that the subject application be restricted to one of the alleged two "inventions" of Group I (Species I - Claims 1-10) and Group II (Species II - Claims 11-12). Responding by telephone on 8/15/03 thereto, Applicants provisionally elected, with traverse, the Group I invention presently defined by Claims 1-10. Applicants confirm such election, but respectfully request reconsideration and withdrawal of the restriction requirement.

It is not readily understood that examining the alleged two Group inventions would cause a serious burden on the PTO. On the other hand, the alleged two Group inventions resulting from the restriction requirement would cause Applicants additional expenses and time to prosecute separate patent applications. The burden placed upon Applicants for filing separate cases directed to each of the groups is respectfully submitted not to be outweighed by the burden placed upon the Patent Office by a non-coextensive examination of these groups in one application. Consequently, in the interest of efficiency, it is respectfully submitted that the restriction requirement is untenable and ought to be withdrawn.

The Examiner is respectfully requested to further reconsider the restriction requirement under 35 U.S.C. §121 to elect a single invention. The requirements of §121 are that the inventions be independent and distinct. Both requirements are necessary to maintain a restriction requirement. Applicants respectfully maintain that the Examiner has not focused upon the two requirements of being independent and distinct. It is noted that M.P.E.P. §802.01 provides a definition of independent as follows:

Th t rm "indep ndent" [i.e., not depend nt] means that  
ther is no disclosed relationship betw n the two or

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more subjects disclosed, that is, they are unconnected in design, operation or effect, for example, [1] species under a genus which species are not usable together as disclosed or [2] process and apparatus incapable of being used in practicing the process.

The Examiner attempts to justify the restriction requirement on the basis that Species I, as represented by Figure 1, contains a piston that is a separate element from the closures. Then the Examiner attempts to find that Species II, as represented by Figs 9 and 10, contains a piston that is a part of one of the closures.

The justification for the restriction requirement is without merit. Claims 1-10 (Group I – Species I) and Claims 11-12 (Group II – Species II) claim "a wafer like piston disposed co-axially within said sleeve." It is the claims that define the invention, not the drawings, and the claims in the present application do not merit being restricted into two group inventions.

For the above reasons, reconsideration of the restriction requirements for the alleged two Group inventions set for the in the outstanding Office Action is respectfully requested.

## 2. Remarks on the Amendment

Claim 1 has been amended to more specifically define Applicants' claimed invention. Antecedent basis for the amendment can be found in the Specification as filed, more specifically on page 2, lines 1-5; page 5, lines 11-13; page 8, line 15 through page 9, line 12; page 11, lines 6-12; and the as filed Claims. Applicants respectfully submit that no new matter has been added by the amendments and the new claims.

## 3. Response to Rejection of Claims 1-7, 9 and 10 based upon 35 U.S.C. §103(a)

Claims 1-7, 9 and 10 stand rejected under 35 U.S.C. §103(a) as being

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unpatentable over Shapiro et al (US 6,054,157). This rejection is respectfully traversed by the amendments to Claim 1.

Applicants' claimed invention, defined by Claim 1, is directed to a system for the convenient dispensing of a semi-solid comestible that is difficult to empty from a sleeve of a hermetically sealed container by the use of a spoon or fork. In addition, Applicants claimed invention contains a circumferential seal around the first base and the first end of the container sleeve and a circumferential seal around the second base and the second end of the container sleeve that enables said container to be hermetically sealed to ensure bacterial integrity of the contents of the can. Moreover, in Applicants' claimed invention, the wafer-like piston is disposed adjacent to the second base.

Applicants claimed invention is neither disclosed nor obvious from Shapiro et al. More specifically, Shapiro et al. relates to a cute little storing and dispensing device for refrigerated cookie dough so that the homemade cookie maker can cut the extrudate to obtain nice uniform cookies and is not related by form, function or effect to Applicants claimed dispensing system for hardworking people that have to scrape the bottom of the can to get all the pet food out of the can because the pet food cannot be neatly removed by a simple single scoop of a spoon or fork. More specifically, Shapiro et al device is for a solid material that is extrudable, and even requires to be cut with a knife to separate from the container. Moreover, one would be able to remove the entire cookie dough from Shapiro et al's cylinder with one simple single scoop of a spoon or fork because the consistency of the cookie dough which is substantially dissimilar to Applicants' claimed semi-solid comestible.

Applicant draws the Examiner's attention to the comestible contained in the claimed invention because it must be contained in a hermetically sealed container to ensure bacterial integrity of the contents. No one wants to be sick or have a sick animal from a container system that fails to prevent bacterial growth. On the other hand, Shapiro et al. states their cookie dough dispenser is airtight, but in

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reality, it merely uses end caps (12 and 14) without Applicants' claimed circumferential seal, to maintain bacterial integrity in the container. However, Shapiro et al. refrigerates their sweet confection, which implies to one skilled in the art that such prior art device would not prevent bacterial growth and could only be used with refrigeration.

In addition, Applicants claimed invention contains a circumferential seal around the first base and the first end of the container sleeve and around the second base and the second end of the container sleeve. As shown and claimed, the first and second bases are defined by a radial cross-section of said sleeve. This provides a contiguous flat exterior surface of the base and container sleeve for application of the circumferential seal. On the other hand, Shapiro et al would not readily be able to employ Applicants claimed circumferential seal because Shapiro et al seal their cookie dough dispenser with end caps (12 and 14) by means of a snap or interference fit. As shown in Shapiro et al's Figs. 1 and 2, the end caps cover the bottom and part of the sides of the tubular dispenser. As such, the circumferential seal would tend to be difficult to apply to the uneven tubular dispenser-cap external surface compared to Applicants' claimed contiguous flat external surface. Moreover, even if one were to apply a circumferential seal to Shapiro et al's uneven tubular dispenser-cap outer surface, one skilled in the art might expect there to be a lack of bacterial integrity because of leaks developing along the dispenser-cap interface.

Finally, Applicants' claimed invention is unobvious over the cited prior art because Applicants' claimed wafer-like piston is disposed adjacent to the second base. This is counter intuitive to those skilled in the art. More specifically, one skilled in the art would commonly position a wafer-like piston at the top of the container so that the comestible would be inserted into the container and then the wafer like piston would be inserted on top of the comestible.

Shapiro et al. teach the common position and structure because Shapiro et al teach that the cookie dough is filled into the dispenser through the top of the

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dispenser and pushed down by means of a piston from the same side that the cookie dough enters the dispenser. For example, Shapiro et al teach that their dispenser is reusable so that when the dispenser is empty or low on cookie dough, then additional cookie dough is added into the dispenser. It would be counter intuitive to add the new cookie dough from the bottom side of the dispenser such that the newly added cookie dough would come out first and the cookie dough previously remaining in the dispenser would come out last.

However, contrary to Shapiro et al. and contrary to what one skilled in the art would be expected to do, Applicants place the wafer-like piston at the bottom of the container. Applicants teach in their specification that this enables the user to invert the container only one time in order to dispense the comestible. However, Shapiro et al and other prior art teach the piston to be at the top of the container so that the piston can force the cookie dough through the bottom of the container. Shapiro et al. would have no reason to invert their dispenser to obtain the comestible from the same side from which the comestible was added into the container.

Shapiro et al fails as an effective reference to make obvious Applicants' claimed invention. Moreover, one skilled in the art would not have the motivation to modify Shapiro et al cookie dispenser to obtain Applicants claimed invention. Consequently, the Examiner is using hindsight to construct this rejection, which is not permissible.

Therefore, Applicant maintains that the claimed invention is unobvious in view of Shapiro et al. Accordingly, Applicant respectfully requests withdrawal of the rejection of Claims 1-7, 9 and 10 based upon 35 U.S.C. §103(a).

#### 4. Response to Rejection of Claim 8 based upon 35 U.S.C. §103(a)

Claim 8 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Shapiro et al (US 6,054,157) as applied to Claim 1 above, and further in view of

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DeCoster (US 5,082,135) and Bateman et al (US 4,179,040). This rejection is respectfully traversed.

The deficiencies of Shapiro et al are discussed above. Neither DeCoster nor Bateman correct the deficiencies of Shapiro et al. Therefore, Applicant maintains that the claimed invention is unobvious in view of the prior art. Accordingly, Applicant respectfully requests withdrawal of the rejection of Claim 8 based upon 35 U.S.C. §103(a).

It is respectfully submitted that Claims 1-10, the pending claims in the application, are now in condition for allowance and such action is respectfully requested.

Applicant's Agent respectfully requests direct telephone communication from the Examiner with a view toward any further action deemed necessary to place the application in final condition for allowance.

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Date of Signature

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